

REMARKS

Claims 1-24 remain for further consideration. No new matter has been added.

The objections and rejections shall be taken up in the order presented in the Official Action.

1. Acknowledgement that claims 1-24 are pending before the Office is correct.

2-3. Claims 1-2, 5-19 and 23-24 currently stand rejected under 35 U.S.C. §103(a) as allegedly being obvious in view of the subject matter disclosed in U.S. Patent 6,298,305 to Kabada et al (hereinafter “Kabada”) combined with the subject matter disclosed in U.S. Patent 4,992,947 to Nimura (hereinafter “Nimura”).

Claim 1 recites a navigation system for use in a motor vehicle. The navigation system recited in amended claim 1 includes, inter alia:

“a first non-volatile memory unit that stores a basic navigation database including road map information;
a communication unit that receives supplemental navigation data including detailed information of digital road maps, and provides received supplemental navigation data; and
a second non-volatile memory unit that receives and stores said received supplemental navigation data;” (cl. 1, emphasis added).

Significantly, the claimed navigation system includes a first non-volatile memory unit and second non-volatile memory unit that store navigation *data*. It is recognized that Kabada fails to disclose first and second memory units (see Official Action, pg. 2). It is then alleged, “[h]owever, Nimura et al disclose a second non-volatile memory unit, and a memory input port receives and stores received supplemental navigation data (see the abstract; and column 4, lines 23-41; and column 6, lines 10-55), a communication unit that receives supplemental navigation

data including detailed information of digital road maps, and provides receives [sic] supplemental navigation data, and a navigation computer receives supplemental navigation data (see column 4, lines 42-65). (Official Action, pgs. 2-3). It is further alleged in the Official Action that a skilled person would have modified Kabada to include the second non-volatile memory unit allegedly disclosed in Nimura (see Official Action, pg. 3). However, a fair and reading reveals that Nimura fails to disclose a second non-volatile memory unit that receives and stores said received supplemental navigation data as recited in claim 1. It is respectfully submitted that the contentions regarding what Nimura teaches are incorrect for several reasons, and those contentions are based upon an overly broad and incorrect reading of this reference. We shall now discuss some of those reasons.

First, although not specified in the Official Action, it appears that the Official Action is contending that the claimed second non-volatile memory reads on the non-volatile RAM 16 disclosed in Nimura. However, this can not be true since claim 1 recites that the second non-volatile memory unit receives and stores said received supplemental navigation data – and that the supplemental navigation data including detailed information of digital road maps. Nimura clearly states that the information stored in the non-volatile RAM 16 is “...*flag information indicating the ordinary operating state and help processing, route information expressed as a series of intersections and a series of nodes, information indicative of present position and data indicative of departure point, initial departure point and desired destination.*” (col. 4, lines 36-41). Nimura neither discloses nor suggests storing information of digital road maps in the non-volatile RAM 16. In addition, in claim 1 the second non-volatile memory stores the supplemental navigation data received by the communication unit. Similarly, Nimura clearly

neither discloses nor suggests a communication unit that includes a wireless receiver as recited in claim 2.

Second, the information stored in the non-volatile RAM 16 of Nimura can not be considered to be supplemental navigation data as recited in claim 1. That is, in claim 1 the system uses information from the basic navigation database stored in the first non-volatile memory unit and the supplemental navigation data stored in the second non-volatile memory unit. The basic navigation data and the supplemental navigation data are from two different sources. In contrast, in Nimura the information stored in the non-volatile RAM 16 is simply selected parts of the data stored on the memory unit/CD-ROM 4. That is, it is information from the memory unit/CD-ROM 4 that was being used when the car was shut-off. It is not *supplemental* information since it came from the memory unit/CD-ROM – **in Nimura there is no information source that is supplemental to the information stored on the memory unit/CD-ROM 1.** Therefore, it is respectfully submitted that Nimura neither discloses nor suggests storing of supplemental navigation information as claimed.

Third, there is no teaching of “a communication unit that receives supplemental navigation data including detailed information of digital road maps, and provides received supplemental navigation data;” (cl. 10). Under the construction of Nimura set forth in the Official Action, or any construction based upon a fair and proper reading Nimura, there is no communication unit that receives the supplemental navigation information. In Nimura the information to be written to the non-volatile RAM 16 is already in the memory unit 4 (see Nimura – FIG. 1) - there is no reason to use a communication unit that receives the supplemental navigation information and provides the received supplemental navigation information.

Therefore, for any one of the foregoing reasons, even if Kadaba and Nimura were properly combinable the resultant combination stills fails to disclose or suggest a number of features of the claimed invention.

In addition, it is respectfully submitted that a prima facie case of obviousness has not been presented. *“Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching suggestion or incentive supporting the combination.”* In re Geiger, 2 U.S.P.Q.2d 1276, 1278 (Fed. Cir. 1987). *“Although the Commissioner suggests that [the structure in the primary prior art reference] could readily be modified to form the [claimed] structure, ‘[t]he mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification.’”* In re Laskowski, 10 U.S.P.Q.2d 1397, 1398 (Fed. Cir. 1989), citing In re Gordon, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984). In addition, *“[w]hen the incentive to combine the teachings of the references is not readily apparent, it is the duty of the examiner to explain why the combination of the reference teachings is proper.”* Ex parte Stone, 2 U.S.P.Q.2d 1788, 1790 (Bd.App. & Int’f 1986) (emphasis added).

As noted above, it is fundamental that obviousness can not be established absent some teaching to combine the references, or a suggestion or incentive supporting the combination of references. See In re Geiger, at 1278 (Fed. Cir. 1987). In the instant case the Official Action is lacking the necessary factual, non-conclusionary explanation why the combination of the Kadaba and Nimura is proper. Hence, it is respectfully submitted that a prima facie case of obviousness has not been presented since there is no proper teaching, suggestion or incentive that would lead

one of ordinary skill in the art to modify Kadaba based upon the teachings of Nimura to create the claimed invention.

Claim 23 recites a method that includes:

“storing in a first non-volatile memory unit connected to the navigation computer, a basic database that includes digital road map information, which is needed to calculate the driving route;

receiving data supplementary to the basic database, such as detailed information of digital road maps, over a network connection to a communication unit that is connected to the navigation computer; and

storing the received supplementary data in a second non-volatile memory unit that is connected to the navigation computer.” (emphasis added, cl. 23).

Significantly, this method involves storing navigation related data in first and second non-volatile memory units. Accordingly, it is respectfully submitted that claim 23 is patentable for at least all the same reasons as claim 1.

Claim 24 recites a navigation system for use in a motor vehicle that receives starting position data and destination position data and computes driving directions between the starting and destination positions. The navigation system includes, inter alia:

“a first non-volatile memory unit that stores a basic navigation database including road map information;

an RF receiver that receives supplemental navigation data including digital road maps, and provides received supplemental navigation data; and

a second non-volatile memory unit that receives and stores said received supplemental navigation data;

means for outputting said driving directions to the user.” (emphasis added, claim 24).

It is respectfully submitted that claim 24 is patentable for at least all the same reasons as claim 1.

4. Claim 3 currently stands rejected under 35 U.S.C. §103(a) in view of the combined subject matter disclosed in Kabada, Nimura and U.S. Patent 6,128,969 to Van Roekel (hereinafter "Van Roekel").

It is respectfully submitted that this rejection is now moot, since claim 1 is patentable for at least the reasons set forth above.

5. Claim 4 currently stands rejected under 35 U.S.C. §103(a) in view of the combined subject matter disclosed in Kabada, Nimura and U.S. Patent 6,366,622 to Brown et al (hereinafter "Brown").

It is respectfully submitted that this rejection is now moot, since claim 1 is patentable for at least the reasons set forth above.

6. Claims 20-22 currently stand rejected under 35 U.S.C. §103(a) in view of the combined subject matter disclosed in Kabada, Nimura and U.S. Patent 6,334,089 to Hessing (hereinafter "Hessing").

It is respectfully submitted that this rejection is now moot, since claim 1 is patentable for at least the reasons set forth above.

For all the foregoing reasons, reconsideration and allowance of claims 1-24 is respectfully requested.

If a telephone interview could assist in the prosecution of this application, please call the undersigned attorney.

Respectfully submitted,



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